

BRER.01US01

REMARKS

Claims 1-6, 8-14, 16, and 17 are currently pending in the above-identified patent application.

In the subject Office Action, made final, the Examiner rejected claims 1, 3, 8, 10, 11, 13, and 16 under 35 U.S.C. 102(b) as being unpatentable over Nolen (U.S. Patent No. 590,330) since, as stated by the Examiner, Nolen shows the claimed invention, and Nolen's pin (a3) is considered "flexible" since virtually anything will flex if enough pressure is applied to it. Applicant respectfully disagrees with the Examiner concerning this ground of rejection for the reasons to be set forth hereinbelow.

Claims 2, 4, and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen since the Examiner asserted that Nolen shows the claimed invention, except that Nolen is silent about what material pin (a3) is made of and the location of the hole through which pin (a3) extends with respect to the open portion of the thumb ringlet (a4). The Examiner continued that to select a well-known material such as plastic for Nolen's pin (a3) would have been obvious to one having ordinary skill in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. The Examiner also concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange Nolen's open portion so that it is disposed approximately opposite to the hole in the thumb ringlet (a4), since it has been held that rearranging parts of an invention involves only routine skill in the art. Applicant respectfully disagrees with the Examiner concerning this ground of rejection for the reasons to be set forth hereinbelow.

Claims 6 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Mock (U.S. Patent No. 6,131,291), and claims 9 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Brenton et al. (U.S. Patent No. 5,469,624). Applicant respectfully disagrees with the Examiner concerning these grounds of rejection for the reasons to be set forth hereinbelow.

BRER.01US01

Claim 5 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Examiner made certain art of record, but did not apply these references to the subject claims. After carefully reviewing the cited documents, applicant believes that no further response is required.

Turning now to the Nolen reference cited by the Examiner, in Col. 2, lines 57-66, it is stated that: "Upon the handle A², adjacent to its rear end, is mounted a thumb-holder or ring, a², preferably of sheet metal, pivoted thereto by means of a double-headed pin or rivet a³, headed loosely enough to permit said ring to be rotated on the surface of the handle in any direction desired and be retained generally at right angle or across the handle when the blades are pushed away from the operator." (emphasis added by applicant). In Col. 3, lines 4-9, it is stated that: "Although the thumb-handle A² is preferably provided with the ring a² as a thumb-retainer, the thumb-retainer may be in the form of a loop, as shown at a⁴ in Fig. 6, that is pivotally retained by means of the double-headed pin a³." (emphasis added by applicant).

The Second College Edition of The American Heritage Dictionary, copyright 1982 by Houghton Mifflin Company, defines a rivet as: "A metal bolt or pin having a head on one end, used to fasten metal plates or other objects together by inserting the shank through a hole in each piece and hammering down the plain end so as to form a new head." The word "flexible" is defined as: "Capable of being bent or flexed; pliable. ... Synonyms: flexible Flexible refers to the ability of a thing to be bent, twisted, or turned without breaking," (emphasis added by applicant). Similar definitions may be found in The American Heritage Dictionary of The English Language, 3rd Ed., Copyright 1992 by the Houghton Mifflin Company, except that "flexible" has the alternative definition: "Capable of being bent repeatedly without injury or damage."

In the subject Office Action, the Examiner rejected claims 1, 3, 8, 10, 11, 13, and 16 under 35 U.S.C. 102(b) as being unpatentable over Nolen (U.S. Patent No. 590,330, stating that Nolen shows the claimed invention, and that Nolen's pin (a3) is

BRER.01US01

considered "flexible" since virtually anything will flex if enough pressure is applied to it. As can be seen from the requirement of a rivet by Nolen, a metal pivoting device is contemplated. Metals cannot be repeatedly bent without work hardening and breaking which does not meet the requirement of a "flexible pin" recited in subject claims 1 and 11, as originally filed. Additionally, the very specific language of Nolen: "... said ring to be rotated on the surface of the handle in any direction desired and be retained generally at right angle" (emphasis added by applicant), specifically requires virtually no flexibility of the rivet.

Moreover, Nolen specifies thumb holder a² as either a ring or a loop, not a "substantially circular thumb ringlet having an open portion and a hole" as recited in subject claims 1 and 10, as amended by applicants in Amendment C dated June 24, 2005.

Applicant therefore believes that Nolen in fact does not anticipate the present claimed invention; rather, Nolen teaches away therefrom.

Applicant respectfully disagrees with the Examiner's assertion that Nolen shows the claimed invention except that it is silent about the material the pin (a3) is made of, and the location of the hole through which the pin (a3) extends with respect to the open portion of the thumb ringlet (a4), in the rejection of claims 2, 4, and 12 under 35 U.S.C. 103(a) as being unpatentable Nolen, and the Examiner's conclusion that to select a well-known material such as plastic for Nolen's pin (a3) on the basis of its suitability for the intended use, would have been obvious to one having ordinary skill in the art. As noted hereinabove, Nolen clearly meant that a metal pin be utilized because that is the well-known meaning of the word "rivet."

Applicant also respectfully disagrees with the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange Nolen's open portion so that it is disposed approximately opposite to the hole in the thumb ringlet (a4), since it has been held that rearranging parts of an invention involves only routine skill in the art. As shown in Fig. 6 of Nolen, the pivot mount must be located near the open end of the loop if the stated use of the loop in Col. 3, lines 9-11: "As the loop a⁴ has one end open it can be used also as a hook to suspend the scissors from the garments of a

BRER.01US01

person.", is to be realized. To place the point of rotation elsewhere would effectively defeat the suspension function of the loop.

Claims 6 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Mock (U.S. Patent No. 6,131,291), and claims 9 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Brenton et al. (U.S. Patent No. 5,469,624). As stated hereinabove, Nolen clearly teaches away from the present claimed invention, and cannot properly be combined with other references in a rejection under 35 U.S.C. 103(a) as has been done by the Examiner. Since the Examiner has incorrectly combined Nolen with Mock and Brenton et al., applicant believes that the Examiner has failed to make a proper *prima facie* case of obviousness as is required under 35 U.S.C. 103(a) in the rejection of claims 6 and 14, claims 9 and 17, respectively.

In view of the discussion presented hereinabove, applicant believes that subject claims 1-6, 8-14, 16, and 17 are in condition for allowance or appeal, the former action by the Examiner being earnestly solicited at an early date.

Reexamination and reconsideration are respectfully requested.

Date: September 13, 2005

Respectfully submitted,

COCHRAN FREUND & YOUNG LLC

By: 

Samuel M. Freund

Reg. No. 30,459

2026 Caribou Drive, Suite 201

Fort Collins, Colorado 80525

Phone: (970) 492-1100

Fax: (970) 492-1101

Customer No. 27,479